Action. Reconsideration of this application in light of the amendment and the allowance of this application are respectfully requested.

I. Double Patenting Rejection

In the Official Action, the Examiner rejected claims 1-27 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-7 of U.S. Patent No. 6,185,611 [to Waldo et al. (hereinafter, Waldo)]. According to the Examiner:

> [a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and U.S. Patent No. 6,185,611 disclose a distributed system having a lookup discovery service and lookup services with associated network services with client[s] accessing network services.
>
> (March 26, 2003 Official Action at page 2.)

Applicants disagree.

A careful reading of Waldo reveals that it does not claim a lookup discovery service. As disclosed in the instant application, a lookup discovery service receives client requests and then transmits those requests to one or more lookup services. In Waldo, a discovery server receives a client request, generates a reference to a lookup service, and then transmits the reference back to the client. Discovery servers in Waldo do not forward client requests to lookup services, or to other discovery servers. Waldo more specifically provides that:

> the client sends a multi-cast packet containing code for communication with the client [to the discovery server]. . .After the client sends the multi-cast packet, the discovery

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> server receives the packet and uses the code contained in the packet to send a reference to the lookup service to the client.
>
> (Waldo at col. 10, lines 47-63.)

Stated another way, the client sends a request to the discovery server when it would like to access a lookup service. The discovery server identifies a reference to a lookup service and returns the reference to the client. In view of the significant differences between the claimed subject matter in the present invention, and lookup services and discovery servers in Waldo, it is respectfully asserted that a rejection based on non-statutory double patenting is improper. In other words, Applicants respectfully assert that the claims in Waldo are patentably distinct from the claims of the instant application.

II. Rejection Of Claims Under 35 U.S.C. § 102(e)

On page 4 of the Official Action, the Examiner rejected claims 1-13 and 16-27 under 35 U.S.C. §102(e) as anticipated by Waldo. According to the Examiner, Waldo "discloses the invention including a method and computer-readable medium containing instructions for controlling a data processing system comprising receiving a request by a lookup discovery service to return locator information that facilitates access to a lookup service, and transmitting the request to the lookup service (col. 5, lines 60-67; and col. 3, lines 29-36)." (Id. at page 3.) (emphasis added.) Applicants disagree. As stated above, discovery servers in Waldo do not forward client requests to lookup services, or to other discovery servers. In Waldo, a discovery server receives a client request,

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generates a reference to a lookup service, and then transmits the reference back to the client. The client may then communicate directly with the lookup service.

The present invention as recited in claims 1, 6 and 13 is directed to a method for, *inter alia*, receiving a request by a lookup discovery service and transmitting the request to the lookup service. Claim 17 is directed to a distributed system comprising a first server for receiving a request from a client computer and then facilitating access to a second server. Claim 18 is similarly directed to a system comprising means for receiving a client request by a lookup discovery service, and means for transmitting the client request to at least one of a plurality of lookup services. Claims 19 and 24 are directed to a computer-readable medium containing instructions for receiving a request by a lookup discovery server and transmitting the request to at least one lookup service.

Anticipation under 35 U.S.C. §102(e) requires that each and every claim element be disclosed by the applied reference. Waldo does not teach each and every claim element of claims 1-13 and 16-27 and therefore, as a matter of law, cannot anticipate these claims. That is, Waldo does not teach a method for at least receiving a request by a lookup discovery service and transmitting the request to at least one lookup service, as recited in independent claims 1, 6 and 13, nor does it teach a distributed system comprising a first server for receiving a request from a client computer and then facilitating access to a second server, as recited in independent claim 17, nor does it teach a system comprising means for receiving a client request by a lookup discovery service, and means for transmitting the client request to at least one of a plurality of

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lookup services, as recited in independent claim 18, and nor does it teach a computer-readable medium containing instructions for receiving a request by a lookup discovery server and transmitting the request to a lookup service, as required by independent claims 19 and 24.

III. Rejection of Claims under 35 U.S.C. § 103(a)

In the Official Action claims 14 and 15 were rejected under 35 U.S.C. § 103(a) as unpatentable over Waldo. According to the Examiner:

> Waldo does not necessarily disclose transmitting a request for a plurality of lookup services or returning lookup service locator information for a plurality of lookup services. However, it would have been obvious to one skilled in the art at the time of the invention to exploit the characteristics of the Java programming environment where services appearing as objects, and the flexibility of the distributed system, to be able to transmit a request for a plurality of lookup services and receive locator information for the plurality of lookup services.
>
> (March 26, 2003 Office Action at page 5).

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. § 2143.03 (8th ed. 2001.)) Second, a reasonable expectation of success must exist. Third, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Moreover, each

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of these requirements must "be found in the prior art, and not based on applicant's disclosure." (Id. at § 2143 (8th ed. 2001.))

In the Official Action, the Examiner states that "[i]t would have been obvious to one having ordinary skill in the art at the time of the invention to exploit the characteristics of the Java programming environment." (March 26, 2003 Office Action at 7). This statement alone, with no suggestion or motivation within the references, is not enough. The Examiner is apparently taking Official Notice by relying on personal knowledge regarding the nature of "the Java programming environment." The Examiner is respectfully reminded of the provisions of MPEP § 2144.03, and the precedents provided in *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999) and *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). An Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. It is never appropriate to rely solely on "common knowledge" without evidentiary support in the record as the principle evidence upon which a rejection is based. Accordingly, Applicant traverses the Official Notice and requests that the Examiner either cite a competent prior art reference in substantiation of these conclusions, or else withdraw the rejection.

Moreover, Waldo fails to disclose any suggestion or motivation to modify it in the manner the Examiner suggests. Even if the claimed invention is within the capabilities of one of ordinary skill in the art, this alone, is not sufficient to establish *prima facie*

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obviousness. *See* M.P.E.P. § 2143.01. Consequently, the rejection does not meet this prong of the obviousness test.

In addition to the lack of motivation or suggestion to combine, there is no reasonable expectation of success that implementing Waldo with Java programming would yield a reasonable probability of success. The Examiner has provided no evidence to the contrary. The obviousness rejection should fail for this reason as well.

Even if there were a motivation to combine reference teachings and some reasonable expectation of success, Waldo fails to teach or suggest all the claim elements. As stated above, Waldo does not teach, suggest or disclose a lookup discovery service as claimed. In Waldo, a discovery server receives a client request, generates a reference to a lookup service, and then transmits the reference back to the client. Discovery servers in Waldo do not forward client requests to lookup services, or to other discovery servers.

For at least the above reasons, no prima facie case of obviousness has been made. Accordingly, reconsideration and withdrawal of the rejection of claims 14 and 15 under 35 U.S.C. § 103 is in order and respectfully requested. This application is in condition for allowance.

Prompt and favorable consideration of this application is requested.

Attached hereto is a marked-up version of the changes made to claims 17 and 18 by this amendment. The attached page is captioned "**Version with markings to show chang s mad .**" Deletions appear as normal text surrounded by [ ] and

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additions appear as underlined text.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: _____
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Dated: June 26, 2003

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please amend claims 17 and 18 as follows:

17. (Amended) A distributed system with a plurality of services, comprising:

a first server computer having a memory containing a lookup discovery service for facilitating access to at least a second server computer;

a second server computer having a memory containing a lookup service having stubs for facilitating access to a plurality of services and having a processor for running the lookup service; and

a client computer having a memory containing a program that transmits a request to the first server computer and having a processor for running the program; wherein the first server receives the request from the client and then transmits the request to at least one of a plurality of second servers, wherein the request provides [to provide] locator information that provides access to a lookup service associated with the second server computer[, and having a processor for running the program].

18. (Amended) A system having a first computer with a client and a second computer with a lookup service containing stubs used for accessing associated services and a third computer with a lookup discovery service containing lookup service locator information for facilitating access to the lookup service, the system comprising:

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means for sending a request by the client to the lookup discovery service identifying one of the associated lookup services to be accessed;

means for receiving the request by the lookup discovery service;

means for transmitting client request to at least one of a plurality of lookup services [accessing a lookup service] that satisfies the client's request;

means for returning the locator information corresponding to the lookup service; and

means for receiving the locator information by the client.

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